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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,246	09/03/2004	Jerry Dusich	A4-1802	5245
27127	7590	09/14/2006	EXAMINER	
HARTMAN & HARTMAN, P.C. 552 EAST 700 NORTH VALPARAISO, IN 46383			OSELE, MARK A	
			ART UNIT	PAPER NUMBER
			1734	

DATE MAILED: 09/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/711,246	DUSICH, JERRY
	Examiner Mark A. Osele	Art Unit 1734

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 31 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,3-8 and 17-30 is/are rejected.
- 7) Claim(s) 2 and 9-16 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 03 September 2004 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-30, drawn to a tape dispenser, classified in class 156, subclass 526.
  - II. Claim 31, drawn to a method of positioning structural members of a building roof, classified in class 52, subclass 745.06.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus can be used to apply an adhesive tape to the surface of any structure for any reason, such as masking before painting or creating a decorative element.

2. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with Domenica Hartman on August 18, 2006 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-30. Affirmation of this election must be made by applicant in replying to this Office action. Claim 31 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3-8, and 17-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Roshia. De Roshia shows a tape dispenser comprising: A frame, 11, comprising spaced apart members, 12, 13, the frame having a lower forward end and a lower rearward end, each of the spaced apart members having a lower edge, 14; a roll of adhesive tape, 100, 106, rotatably mounted between the spaced-apart members so the tape is dispensed from the roll and travels from the forward end to the rearward end of the frame (See Fig. 8); lateral guides, 108, pivotably attached to the spaced-apart members, each of the guides being attached so that a portion thereof is pivotable to a position below the lower edge of its respective spaced-apart member; a member, 34, disposed between the lower edges of the spaced-apart members and applying a downward pressure on the tape traveling from the forward end to the

rearward end of the frame; means, 115, for severing the tape at the rearward end of the frame; a handle attached to the frame for pushing the frame in the forward direction. It is noted that the cross bar between the two spaced apart members 12 and 13 is a handle. Furthermore, the apparatus of Figs. 8 and 9 turned upside down will make edges 14 lower edges. De Roshia fails to show the pressure applying member to be resilient. It would have been obvious to use a resilient pressure applying member in the apparatus of De Roshia because it is conventional to make tape applying rollers resilient to accommodate for slight variations in the surface to which the tape is applied so the tape can be applied with uniform pressure across its width.

Regarding claims 3, 4, and 5, the lateral guides are pivotably attached to the spaced apart side members in the manner of the instant claims.

Regarding claims 8 and 17, the distance between the spaced apart members is dependent upon the width of the masking tape/paper being applied. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use spaced apart members only as wide as necessary to hold the tape being applied so that the dispenser can reach into narrow spaces for applying the tape.

Regarding claims 6 and 18-30, limitations directed to the tape are only limitations of materials worked upon by the apparatus and are therefore not given patentable weight in an apparatus claim. Limitations to materials worked upon would be given patentable weight in "system" claims wherein the system positively recites both the apparatus and the material worked upon, in this case the dispenser and the adhesive tape, respectively.

Regarding claim 7, the cross bar between spaced apart members 12 and 13, would comprise means for clamping an extension thereto.

***Allowable Subject Matter***

6. Claims 2, 9-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter: None of the prior art suggests adding means for slitting the tape lengthwise as the tape travels from the forward end to the rearward end of the frame. Furthermore, tape dispensers commonly include windows in frame members are conventional to view the amount of tape left to be dispensed, the frame members of De Roshia are not wide enough to warrant windows for viewing the roll of tape.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Flowers shows a tape dispenser with all of the claimed subject matter except for a cutter and a pivotable member. The additionally cited references each show tape applicators either with similar structures to the instantly claimed invention or showing particularly claimed features of the instant claims, eg pivoting guide members.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A. Osele whose telephone number is 571-272-1235. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



MARK A. OSELE  
PRIMARY EXAMINER

September 11, 2006